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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

RSW920000127US1 (5577-321)

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Signature

Typed or printed name

Traci A. Brown

Application Number

09/782,772

Filed

February 13, 2001

First Named Inventor

Renee M. Kovales

Art Unit

2645

Examiner

Joseph T. Phan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 42,011☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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Telephone number

April 4, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE EXAMINING GROUP 2645**

Attorney Docket No. RSW920000127US1 (5577-321)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Kovals et al.

Serial No.: 09/782,772

Filed: February 13, 2001

For: RECORDING AND RECEIVING VOICEMAIL WITH FREEFORM BOOKMARKS

Confirmation No.: 2011

Examiner: Joseph T. Phan

Group Art Unit: 2645

Date: April 4, 2006

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Traci A. Brown

**REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program.

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicants request that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to IBM's Deposit Account No. 09-0461.

REMARKS

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed January 4, 2006 (hereinafter "Final Action"). The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

Applicants respectfully submit that many of the recitations of the pending claims are not

met by the cited reference for at least the reasons discussed herein and in Applicants' previously filed Amendment of September 29, 2005. Therefore, Applicants respectfully request review of the present application by an appeal conference prior to the filing of an appeal brief. In the interest of brevity and without waiving the right to argue additional grounds should this Petition be denied, Applicants will only discuss the recitations of independent Claims 1, 33, and 57, and dependent Claims 13, 45, and 70.

The 35 U.S.C. § 102 Rejection

Independent Claims 1, 33, and 57 along with dependent Claims 5, 43, and 60 stand rejected under 35 U.S.C. §102(b) as being anticipated by U. S. Patent No. 5,943,402 to Hamel et al. (hereinafter "Hamel"). (Final Action, page 3). Independent Claims 1, 33, and 57 are directed to a method, a system, and a computer program product, respectively. Independent Claim 1 recites:

providing at least one bookmark for a voice mail message by a caller leaving the voice mail message;
wherein at least one bookmark is used to mark one or more segments of the voice mail message as having one or more different degrees of importance.

Claims 33 and 57 include similar recitations. Thus, according to the independent claims, a caller leaving a voice mail message may provide one or more bookmarks of which at least one of the bookmark(s) is used to mark one or more segments of the voice mail message according to degree(s) of importance.

The Final Action cites col. 3, lines 16 - 55, col. 4, lines 55 - 67, col. 5, lines 34 - 48, and col. 8, lines 35 - 67 of Hamel as disclosing this aspect of the present invention. (Final Action, page 3). Applicants respectfully disagree with this interpretation of the teachings of Hamel. The passage of Hamel at col. 8, lines 35 - 67 describes an example in which a subscriber elects to send a voice mail message in which various acoustic bullets are used to divide the message into segments including one bullet that is used to separate the original message from new comments (segment 418a). (Hamel, col. 8, lines 46 - 64). In referring to a message segment, the Final Action alleges that, according to Hamel, "it is important if it is interrupted/bookmarked." (Final Action, page 3). Applicants, however, can find no discussion in Hamel that the acoustic bullets

are used to indicate that one segment is more important than another segment or that a segment identified by an acoustic bullet is more important than portion(s) of the message that are not marked with an acoustic bullet. Applicants, therefore, respectfully submit that Hamel does not disclose or suggest using one or more bookmarks to mark one or more segments of a voice mail message according to degree(s) of importance as recited in independent Claims 1, 33, and 57.

In response to these arguments, the Final Action states that "[i]t is understood that marked segments are important to the caller if he/she bookmarks/interrupts the message." Applicants respectfully disagree with this interpretation of the teachings of Hamel. Applicants can find no discussion in Hamel that a marked segment is more or less important than an unmarked segment.

The Final Action further states that the recitation "mark one or more segments of the voice mail message as having one or more different degrees of importance" can be interpreted as "mark one or more segments of the voice mail message as having one degree of importance." Applicants disagree with this rephrasing of the language from Claim 1. Applicants submit that the recitation can be interpreted as "mark one or more segments of the voice mail message as having one different degree of importance." Applicants submit that the Examiner's removal of the word "different" from the claim language is improper. Applicants submit that Hamel does not disclose or suggest marking a segment of a voice mail message as having a different degree of importance from other portions of the voice mail message.

Applicants submit, therefore, that Hamel does not disclose, at least, the recitation **"wherein at least one bookmark is used to mark one or more segments of the voice mail message as having one or more different degrees of importance."** Moreover, Claims 33 and 57 include similar recitations. Therefore, Applicants respectfully requests that the present application be reviewed and the rejection of independent Claims 1, 33, and 57 be reversed by the appeal conference prior to the filing of an appeal brief.

Various Dependent Claims are Separately Patentable

Dependent Claims 2 - 4, 6 - 32, 34 - 42, 44 - 56, and 58, 59, and 61 - 91 are patentable at least as they depend from patentable independent Claims 1, 33, and 57. Applicants further submit, however, that various dependent claims are separately patentable for at least the reasons


discussed hereafter.

Dependent Claims 13, 45, and 70 stand rejected under 35 U.S.C. §102(b) as being anticipated by Hamel. Applicants respectfully submit that Hamel does not appear to contain any disclosure with respect to using labels or markers to mark a segment of a voice mail message as protected or confidential. The Final Action alleges that the voice mail message described in Hamel is protected/confidential because no one else can retrieve it. (Final Action, page 6).

Applicants can find no such description in Hamel that the voice mail message is protected/confidential. Moreover, even if the entire voice mail message in Hamel was limited to retrieval by only the intended recipient, Hamel contains no disclosure with respect to using bookmarks to identify segments of a voice mail message as protected or confidential.

Accordingly, for at least the additional reasons discussed above, Hamel does not disclose the recitations of dependent Claims 13, 45, and 70. Therefore, Applicants respectfully request that the present application be reviewed and the rejection of dependent Claims 13, 45, and 70 be reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,


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